



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Frank GUARNIERI

Appl. No. 09/183,267

Filed: October 30, 1998

For: **Computational Protein Probing to
Identify Binding Sites**

Confirmation No. 2934

Art Unit: 1631

Examiner: Borin, M.L.

Atty. Docket: 1866.0010001/JMC/DAK
(formerly SAR-12902)

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

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TECH CENTER 1600/2900

Sir:

In reply to the Office Action dated July 29, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 1-7 and 11-14. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

The Examiner asserts that Group I, represented by claims 1-7 and 11-14, and Group II, represented by claim 8, are independent inventions. The Examiner alleges that the methods have different steps, different functions, and different effects. The Examiner asserts that with regard to the reference to claim 3 made in claim 8: "claim 8 is drawn to identifying chemical characteristics of [] chemical compounds; the method of arriving at said chemical compound [] is not relevant for the claimed method of claim 8. A reference teaching [a] method of identifying chemical characteristics of a compound . . . will not teach or suggest the method of Group I." Applicant traverses for at least the following reason.

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803. Applicant respectfully submits that the Examiner has not demonstrated that searching the subject matter of Group II would impose a serious burden over searching the subject matter of Group I. Searching the art pertaining to the identification of macromolecule-binding compounds by examining the functionalities and relative orientations of the organic fragments found in a cluster pursuant to a binding site identifying method would necessarily involve searching the art pertaining to the referenced binding site identifying method. Without executing the binding site identifying method, there are no organic fragments found in a cluster to examine. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions

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of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: Dec. 27, 2002

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